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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			EXAMINER FISCHER, ANDREW J	
			ART UNIT	PAPER NUMBER
			3627	
DATE MAILED: 01/09/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/817,597

Applicant(s)

NAKADE ET AL.

Examiner

Andrew J. Fischer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,7,8 and 10-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,7,8 and 10-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 C.F.R. §1.114

1. A request for continued examination (“RCE”) under 37 C.F.R. §1.114, including the fee set forth in 37 C.F.R. §1.17(e), was filed in this application on September 29, 2005. This application was under a final rejection (the Second Final Office Action, mailed May 7, 2005) and is therefore eligible for continued examination under 37 C.F.R. §1.114. Because the fee set forth in 37 C.F.R. §1.17(e) has been timely paid, the finality in the previous First Final Office Action has been withdrawn pursuant to 37 C.F.R. §1.114.

Acknowledgements

2. In accordance with the RCE noted above, Applicants’ amendment filed September 29, 2005 is acknowledged and has been entered. Accordingly, claims 1-4, 7, 8, and 10-22 remain pending.

3. This Office Action, the “Third Non Final Office Action” is given Paper No. 20060102.

4. All references in this Office Action to the capitalized versions of “Applicants” refers specifically the Applicants of record. References to lower case versions of “applicant” or “applicants” refers to any or all patent “applicants.” Unless expressly noted otherwise, references to “Examiner” in this Office Action refers to the Examiner of record while reference to or use of the lower case version of “examiner” or “examiners” refers to examiner(s) generally.

5. This Office Action is written in OACS. Because of this, the Examiner is unable to control formatting, paragraph numbering, font, spelling, line spacing, and/or other word processing issues. The Examiner sincerely apologies for these errors.

Specification

6. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 C.F.R. §1.75(d)(1), MPEP §608.01(o), and MPEP §2181.

Correction of the following is required:

- i. The “first means for transmitting audio data” as recited in claim 14.

Claim Rejections - 35 USC §112 2nd Paragraph

7. The following is a quotation of the 2nd paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-4, 7, and 10-22 are rejected under 35 U.S.C. §112, 2nd paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are replete with errors. Some examples follow:

- a. In claim 1, the phrase “said second image being promoted by the communications terminal apparatus utilized by the first user to the communications terminal apparatus utilized by a second user” does not make sense since “promoted” does not means sending.

- b. In claims 1 and 14, it is unclear how the detailed information is supplied in response to “a demand from . . . an environment for performing transactions” In particular, it is unclear how “an environment” can make a demand.

- c. Also in claims 1 and 14, it is unclear what “is proposed to the one of said plurality of communication terminal apparatus” Additionally, it is unclear clear how first objects (e.g. things, ideas, people) can be “proposed” to a second object.

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Claim Rejections - 35 USC §102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office Action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-4, 7, 8, and 10-22, as understood by the Examiner, are rejected under 35 U.S.C. §102(e) as being anticipated by Balter et. al. (U.S. 6,901,379 B1) (“Balter”). Balter discloses the claimed invention including sending both audio and video via the Internet and a user’s browser. Balter also discloses detailed information about one or more products (visual information). Moreover, because web pages are requested by a user’s computer, the system discloses the supply is in response to a demand.

Claim Rejections - 35 USC §103

11. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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12. Claims 1-4, 7, 8, and 10-22, as understood by the Examiner, are rejected under 35 U.S.C. §103(a) as being unpatentable over Balter in view of Muller's Desktop Encyclopedia of the Internet ("Muller") and Gralla's How the Internet Works ("Gralla").¹ It is the Examiner's principle position that the claims are anticipated because the features disclosed in Muller and Gralla are simply those that are inherent in the Internet.

However if not inherent, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Balter as taught by Muller and Gralla to include their various disclosed features of the Internet. Such a modification would have simply disclosed that which is inherent and made Balter a more complete reference.

13. For due process purposes and because Applicants have not objectively indicated and redefined claim limitation(s) to have meanings other than their ordinary and accustomed meanings, the Examiner confirms that Applicants have decided not to be their own lexicographer. To support this position, the Examiner again notes the following factual findings as first discussed in the previous Office Actions.² First, the Examiner has again carefully reviewed the specification and prosecution history and can not locate any lexicographic definition(s). Second, the Examiner finds that not only have Applicants not pointed to definitional statements in their specification or prosecution history, Applicants have also not

¹ See MPEP §2112 expressly authorizing alternative §102/§103 rejections when the question of inherency is present in the anticipation rejection.

² See the "Second Non Final Office Action" mailed July 7, 2005, Paragraph No. 19 beginning on page 8; the "Second Non Final Office Action" mailed February 2, 2005, Paragraph No. 29 beginning on page 8.

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pointed to a term or terms in a claim with which to draw in those statements³ with the required clarity, deliberateness, and precision.⁴ Third, after receiving express notice of the Examiner's position that lexicography is *not* invoked,⁵ Applicants' responses have not point out the "supposed errors" in the Examiner's position regarding lexicography invocation in accordance with 37 C.F.R. §1.111(b) (i.e. Applicants did not argue lexicography *was* invoked). Forth and to be sure of Applicants' intent, the Examiner also notes that Applicants have declined the Examiner's express invitation⁶ to be their own lexicographer. Finally, after receiving express notice of the preceding factual findings and conclusions, Applicants' latest response again fails to point out the supposed errors in the Examiner's position regarding lexicography invocation in accordance with 37 C.F.R. §1.111(b). Moreover, Applicants' latest response—while fully considered by the Examiner—does not change the Examiner's reasonable conclusion that Applicants have decided not to be their own lexicographer. Therefore (and unless expressly

³ "In order to overcome this heavy presumption in favor of the ordinary meaning of claim language, it is clear that a party wishing to use statements in the written description to confine or otherwise affect a patent's scope must, *at the very least*, point to a term or terms in the claim with which to draw in those statements. [Emphasis added.]" *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).

⁴ "The patentee's lexicography must, of course, appear 'with reasonable clarity, deliberateness, and precision' before it can affect the claim." *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1249, 48 USPQ2d 1117, 1121 (Fed. Cir. 1998) citing *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994).

⁵ See Note 2.

⁶ See *e.g. Fuji Photo Film Co. v. ITC*, 386 F.3d 1095, 72 USPQ2d 1769, 1773 (Fed. Cir. 2004) (noting that applicants' failure to correct the examiner's characterization of an element of claim interpretation is nevertheless an indication of how a claim should be interpreted since applicant declined the examiner's express invitation to correct a possible error in claim interpretation: "applicant's attention was called to the examiner's interpretation of [how the element was interpreted by the examiner, and] applicant was invited to correct the examiner's interpretation—an invitation the applicant did not accept."

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noted otherwise by the Examiner), the heavy presumption in favor of the ordinary and accustomed meaning for claim terminology is confirmed. Accordingly, the claims continue to be interpreted with their “broadest reasonable interpretation,” *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997), and the Examiner continues to rely heavily and extensively on this interpretation.⁷

14. The Examiner maintains his interpretations as stated in the previous Office Actions. Again, to the extent that the Examiner’s interpretations are either different from or in dispute with Applicants’ interpretations, the Examiner hereby adopts the following additional definitions—under the broadest reasonable interpretation standard—in all his claim interpretations. Moreover, the following list is provided in accordance with *In re Morris* and is not intended to be exhaustive in any way.

Promote: “c: to present (merchandise) for buyer acceptance through advertising, publicity, or discounting” Merriam-Webster’s Collegiate Dictionary, 10th Edition, Merriam-Webster Inc., Springfield, M.A., 1997.

15. The Examiner maintains his position that all pending claims do not contain any product-by-process claims.

16. Regarding functional language, the Examiner maintains his position as noted in the previous Office Actions.

⁷ See 37 C.F.R. §1.104(c)(3) which states in part: “the examiner may rely upon admissions by applicant . . . as to *any matter* affecting patentability [Emphasis added.]”

Response to Arguments

17. Applicants' arguments with respect to the pending claims have been considered but are moot in view of the new grounds of rejection.

18. Regarding the objections to the specification, Applicant's response is noted. However the Examiner maintains his position. See the e.g. MPEP §2181.

19. To help maintain compact prosecution, to avoid additional 35 U.S.C. §112, 2nd paragraph objections or rejections, and (if necessary) to aid Applicants in the event they appeal to the USPTO's Board of Patent Appeals and Inferences, the Examiner recommends Applicants review their claims and for every means plus function or step plus function invoking 35 U.S.C. §112 6th paragraph and identified by Applicants, Applicants should indicate the claimed function in addition to expressly setting forth the corresponding structure, material, or acts of the particular claimed function by referring to the specification by page and line number and/or drawings with reference to particular characters noted therein. Applicants should consider this actual notice that such review and indication as described in this paragraph should be made prior to *any* amendment to the claims. However if Applicants have previously indicated the claimed function and the corresponding structure, material, or acts corresponding to that function, Applicants need only point to their response (with reasonable particularity) in which the indication was made.

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Regarding Indefiniteness Under 35 USC §112 2nd Paragraph⁸

20. First, the Examiner notes that the primary purpose of the definiteness requirement is to provide notice. “The primary purpose of the definiteness requirement is to ensure that the claims are written in such a way that they give notice to the public of the extent of the legal protection afforded by the patent, so that interested members of the public, e.g., competitors of the patent owner, can determine whether or not they infringe. That determination requires a construction of the claims according to the familiar canons of claim construction.” *All Dental Prodx, LLC v. Advantage Dental Products, Inc.*, 309 F.3d 774, 779-80, 64 USPQ2d 1945, 1949 (Fed. Cir. 2002) (citations omitted).

21. Second, it is the Examiner’s position that during ex parte examination, if a claim in a utility patent application is indefinite on its face, the claim is indefinite. “If the scope of the invention sought to be patented is unclear from the language of the claim, a second paragraph rejection will properly lie.” *In re Wiggins*, 488 F.2d 538, 179 USPQ 421, 423 (CCPA 1973) (citations and quotations omitted).

22. Third, if a claim is indefinite under 35 U.S.C. §112 2nd paragraph, it is impossible to completely and accurately construe claim of the claim. See *Honeywell International Inc. v. ITC*, 68 USPQ2d 1023, 1030 (Fed. Cir. 2003) (“Because the claims are indefinite, the claims, by definition, cannot be construed.”). However, in accordance with MPEP §2173.06 and the USPTO’s policy of trying to advance prosecution by providing art rejections even though these

⁸ Because this application has now been at least twice rejected and is therefore eligible for appeal to the USPTO’s Board of Patent Appeals and Interferences (“Board”), because of recent decisions by the Board and the Board’s position on indefiniteness, and in order to help and enable Applicants to craft reasoned arguments should Applicants eventually decide to appeal an indefiniteness rejection to the Board, the Examiner has provided the following discussion on indefiniteness under 35 USC §112 2nd paragraph.

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claim are indefinite, the claims are construed and the art is applied *as much as practically possible*.

23. Forth, the Examiner recognizes that breath of a claim is not be equated with indefiniteness. *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). However, “[i]f the language of the claim is such that a person of ordinary skill in the art could not interpret the metes and bounds of the claim so as to understand how to avoid infringement, a rejection of the claim under 35 U.S.C. 112, second paragraph would be appropriate.” MPEP §2173.02 citing *Morton Int’l, Inc. v. Cardinal Chem. Co.*, 5 F.3d 1464, 1470, 28 USPQ2d 1190, 1195 (Fed. Cir. 1993). In other words, claim breath indicates the range or scope a claim limitation covers while the metes and bounds indicate where the claimed subject matter begins and ends. These are two principles (*i.e.* breath v. metes and bounds) are distinct and separate principles. A broad claim—like a narrow claim—may or may not have clear metes and bounds and thus may or may not be definite. Thus, if a person of ordinary skill in the art can not interpret the metes and bounds of a claim—even a broad claim—so as to understand how to avoid infringement, the claim is indefinite as well as broad.

24. Fifth, a claim in a utility patent application is either indefinite under 35 U.S.C. §112, 2nd paragraph or it is not. Contrary to recent decisions of the USPTO’s Board of Patent Appeals and Interferences (“Board”), the law does not recognize a ‘scale’ or ‘range’ of indefiniteness such as ‘slightly indefinite,’ ‘somewhat indefinite,’ or ‘not too indefinite.’ There is no middle ground since at the end of the day, ‘slightly indefinite,’ ‘somewhat indefinite,’ or ‘not too indefinite’ are nevertheless *still indefinite*. The Examiner frequently receives arguments from applicants and decisions from the Board where the parties respectively argue that ‘the examiner knows what is

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meant by the term' or 'the language is clear from the specification.' However these arguments can not overcome claim language that is indefinite on its face. In other words, "semantic indefiniteness of claims is not rendered unobjectionable merely because it *could* have been corrected. [Emphasis in original.]" *Allen Engineering Corp. v. Bartell Industries Inc.*, 299 F.3d 1336, 1349, 63 USPQ2d 1769, 1776 (Fed. Cir. 2002) (citations and quotations omitted).⁹ Again, so as to be especially clear, a claim is either indefinite—or it is not indefinite. When the claim is indefinite, the claim by definition, can not be construed. And if the indefiniteness is rendered during ex parte examination, neither the specification nor the prosecution history can not be used to rectify the indefiniteness.¹⁰

25. Sixth, the Examiner recognizes that "compliance with Section 112 Para. 2 is a question of law." *In re Dossel*, 115 F.3d 942, 944, 42 USPQ2d 1881, 1883 (Fed. Cir. 1997). Additionally, when questions of indefiniteness arise, we use general principles of claim construction. "In the face of an allegation of indefiniteness, general principles of claim construction apply." *Datamize LLC v. Plumtree Software Inc.*, 417 F.3d 1342, 75 USPQ2d 1801, 1805 (Fed Cir. 2005) citing *Oakley, Inc. v. Sunglass Hut Int'l*, 316 F.3d 1331, 1340-41, 65 USPQ2d 1321, 1326 (Fed. Cir. 2003) (noting that a determination of definiteness "requires a construction of the claims

⁹ As a practical matter, a patent applicant virtually always has an opportunity to correct indefiniteness by filing either an amendment to a non final office action, or alternatively if in response to a final office action, a request for continued examination under 37 C.F.R. §1.114 along with an amendment.

¹⁰ Compare *Exxon Research and Engineering Co. v. U.S.*, 265 F.3d 1371, 60 USPQ2d 1272 (Fed. Cir. 2001) vs. *In re Jolly*, 172 F.2d 566, 80 USPQ 504 (CCPA 1949). In *Exxon Research*, the Court of Appeals for the Federal Circuit reviewed "similar claim language" as was interpreted in *Jolly* (where the language in question was held to be indefinite) and held that for purposes of indefiniteness, claims are interpreted differently during ex parte examination than the same claim phases during inter parte litigation.

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according to the familiar canons of claim construction”). However, a patent claim that is indefinite on its face can not be rendered ‘definite’ by a reviewing body simply because the result would be inequitable or unfair to applicant, because the result would be too harsh or severe since it might result in the patent application becoming abandoned, or because rendering the claim indefinite is against a noble yet ill-conceived policy. “Claim construction, however, is not a policy-driven inquiry. As stated earlier, it is a contextual interpretation of language. The scope of patent claims can neither be broadened nor narrowed based on abstract policy considerations regarding the effect of a particular claim meaning.” *SmithKline Beecham Corp. v. Apotex Corp.*, 365 F.3d 1306, 70 USPQ2d 1737, 1742-43 (Fed. Cir. 2004) (quoting *Quantum Corp. v. Rodime, PLC*, 65 F.3d 1577, 1584, 36 USPQ2d 1162, 1168 (Fed. Cir. 1995) (“[I]t is well settled that no matter how great the temptations of fairness or policy making, courts do not redraft claims”), *vacated on other grounds by* 403 F.3d 1328, 74 USPQ2d 1396 (Fed. Cir. 2005)(en banc).

26. Seventh, should Applicants appeal this application and should the Board have any questions regarding indefiniteness under 35 U.S.C. §112, 2nd paragraph and its application during ex parte examination when compared with inter parte litigation, the Examiner respectfully requests the Board to remand this application to the Examiner in order to provide additional guidance.

27. The Examiner concludes this section by reiterating that during ex parte examination, when a patent claim is rejected for indefiniteness because the claim is indefinite on its face, the claim can not be construed. In such a case, the application of prior art by an examiner or the Board is immaterial. Yet in order to avoid piecemeal examination, MPEP §2173.06 states that even if the examiner takes a position that a claim is indefinite, it is USPTO policy to nevertheless make an attempt at application of the prior art. However, neither this policy decision as set forth

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in MPEP §2173.06 nor even *any* policy decision by the USPTO can change the substantive standard for indefiniteness and thus the standard for a 35 U.S.C. §112 2nd paragraph rejection.¹¹ So no matter how slight the indefiniteness may be, no matter how equitable Applicants' arguments may seem, and no matter how great the temptations of fairness or policy making may appear to the Board, during ex parte examination, if a claim is indefinite on its face, the claim is just that—indefinite.

Conclusion

28. References considered pertinent to Applicants' disclosure are listed on form PTO-892.

All references listed on form PTO-892 are cited in their entirety.

29. Unless expressly noted otherwise by the Examiner or other USPTO official, the following four (4) citations to the Manual of Patent Examining Procedure ("MPEP") apply to this Office Action *and* any future office action(s), communication(s), or other correspondence provided by the USPTO: MPEP citations to Chapter 2300 are from the MPEP 8th Edition, Rev. 4, October 2005; citations to Chapters 200-900, 1200-1400, and 1700-1900, 2100, 2200, 2600 are from the MPEP 8th Edition, Rev. 3, August 2005. MPEP citations to Chapters 100, 1000, 1100, 1500, 2000, 2500, and 2700 are from the MPEP 8th Edition, Rev. 2, May 2004. MPEP citations to Chapters 1600, 2300, 2400 are from MPEP 8th Edition, August 2001.

¹¹ See *Merck & Co. v. Kessler*, 80 F.3d 1543, 1559, 38 USPQ2d 1347, 1351 (Fed. Cir. 1996) ("As we [the Federal Circuit] have previously held, the broadest of the PTO's rulemaking powers—35 U.S.C. Section 6(a)—authorizes the Commissioner to promulgate regulations directed only to 'the conduct of proceedings in the [PTO]'; it does not grant the Commissioner the authority to issue substantive rules.").

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30. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

31. Applicants are reminded that patents are written by and for skilled artisans. See *Vivid Technologies, Inc. v. American Science and Engineering, Inc.*, 200 F.3d 795, 804, 53 USPQ2d 1289, 1295 (Fed. Cir. 1999) (“patents are written by and for skilled artisans”). The Examiner therefore starts with the presumption that Applicants are skilled artisans who possess at least ordinary skill in the art. Consequently, it is the Examiner’s position that because the patent references of record are directed to those with ordinary skill in this art, these references are clear, explicit, and specific as to what they teach. Nevertheless some applicants apparently have difficulty understanding the references. In an effort to maintain compact prosecution, provide due process, and to help these applicants understand the contents of a reference when viewed from the position of one of ordinary skill in this art, Applicants are hereby given actual notice that if after reasonably reading any reference of record—whether the reference is currently of record or subsequently made of record—if Applicants can not reasonably understand or if Applicants have difficulty comprehending one or more sentence(s), statement(s), diagram(s), or principle(s) set forth in one or more of the reference(s) of record, Applicants should (in their next appropriately filed response) bring this issue to the attention of the Examiner. In addition to bringing this issue to the attention of the Examiner, and in accordance with 37 C.F.R. §1.111(b), Applicants response must also state *why* they either do not understand or have difficulty

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comprehending the reference. If after properly receiving (*i.e.* Applicants' response is made of record) both Applicant's request for understanding and the reasons as to *why* the request is made—and assuming the reference is germane to at least one outstanding rejection—the Examiner may either provide a substitute reference, or alternatively, do his best to elucidate the particular sentence(s), statement(s), diagram(s), or principles(s) at issue in a reasonable manner. For all documents or references made of record after this Office Action, Applicants are given actual notice that this paragraph becomes effective when Applicants receive notice that the document or reference is made of record (*i.e.* this paragraph becomes applicable when Applicants submit an Information Disclosure Sheet or when Applicants receive an examiner's Notice of References Cited (Form PTO-892).

32. Additionally, Applicants are also reminded that it is inappropriate for the USPTO to disregard any relevant evidence. "It is jurisprudentially inappropriate to disregard any relevant evidence on any issue in any case, patent cases included." *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871, 879 (Fed. Cir. 1983). Second, when making substantive patentability determinations, it is clear error for the USPTO not to consider *all* evidence of record. See *e.g. In re Piasecki*, 745 F.2d 1468, 1471, 223 USPQ 785, 787 (Fed. Cir. 1984) ("All the evidence on the question of obviousness must be considered."); *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992) ("After evidence or argument is submitted by the applicant in response, patentability is determined on *the totality of the record*, by a preponderance of evidence with due consideration to persuasiveness of argument. [Emphasis added.]"); *In re Glaug*, 283 F.3d 1335, 1338, 62 USPQ2d 1151, 1152-53 (Fed. Cir. 2002) ("Patentability *vel non* is then determined on the *entirety* of the record, by a preponderance of evidence and weight of argument. . . . ; patentability is determined by a preponderance of *all*

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the evidence. [Emphasis added.]”); and *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143, 146 (CCPA 1976)(where the court expressly set forth the issue as “Whether, in light of *all the evidence*, the claimed method would have been obvious at the time the invention was made. [Emphasis added.]”). Third, any factual determination by the USPTO that does not consider *all* relevant evidence may not be supported by substantial evidence¹² since the particular evidence *not* considered may be probative of a factual issue presented. Therefore because, inter alia, it is inappropriate for the USPTO to disregard any relevant evidence, because the USPTO must consider all evidence of record, and because any evidence *not* considered by the USPTO may be probative of at least one factual issue presented, Applicants are hereby given actual notice that all prior art rejections (*i.e.* rejection(s) based upon 35 U.S.C. §§ 102 or 103)—if found in this Office Action or any subsequent office action—are based upon the cited reference(s) in the statement of the rejection *in combination* with the knowledge of one of ordinary skill in this art. See *In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995) citing *In re LeGrice*, 301 F.2d 929, 936, 133 USPQ 365, 372 (CCPA 1962).

33. In accordance with the USPTO’s goals of customer service, compact prosecution, and reduction of cycle time, the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has again provided Applicants with notice—for due process purposes—of his position regarding his factual determinations and legal conclusions. The Examiner notes and thanks Applicants for their “Remarks/Arguments” (beginning on page 11) traversing the Examiner’s positions on various points. If Applicants disagree with any additional factual determination or

¹² Substantial evidence is “such relevant evidence as a reasonable mind might accept as adequate to support a conclusion.” *Consolidated Edison Co. v. NLRB*, 305 U.S. 197, 229 (1938).

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legal conclusion made by the Examiner in this Office Action whether expressly stated or implied,¹³ the Examiner respectfully reminds Applicants to properly traverse the Examiner's position(s) in accordance with 37 C.F.R. §1.111(b) in their next properly filed response. By addressing these issues now, matters where the Examiner and Applicants agree can be eliminated allowing the Examiner and Applicants to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time. If Applicants have any questions regarding the Examiner's positions or have other questions regarding this communication or even previous communications, Applicants are strongly encouraged to contact Examiner Andrew J. Fischer whose telephone number is (571) 272-6779. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's immediate supervisor, Alexander Kalinowski, can be reached at (571) 272-6771. The fax number for facsimile responses is now (571) 273-8300.



Andrew J. Fischer
Primary Examiner
Art Unit 3627

AJF
January 3, 2005

¹³ *E.g.*, if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner's implied position that the references are analogous art.